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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,669	02/06/2004	Steffen Dubnack	GK-ZEI-3226/500343.20238	7534
26418	7590 11/27/2006		EXAMI	NER
REED SMITH, LLP ATTN: PATENT RECORDS DEPARTMENT			ROY, ANU	JRADHA
	TON AVENUE, 29TH I		ART UNIT	PAPER NUMBER
NEW YORK, NY 10022-7650			3736	

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)			
	10/773,669	DUBNACK ET AL.			
Office Action Summary	Examiner	Art Unit			
	Anuradha Roy	3736			
The MAILING DATE of this communication app	1				
Period for Reply					
A SHORTENED STATUTORY PERIOD FOR REPLY THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a reply - If NO period for reply is specified above, the maximum statutory period w - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	36(a). In no event, however, may a reply be timed within the statutory minimum of thirty (30) days will apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	nely filed s will be considered timely. the mailing date of this communication. D (35 U.S.C. § 133).			
Status					
1)⊠ Responsive to communication(s) filed on 18 Se	eptember 2006.				
<u> </u>	action is non-final.				
,—	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.				
Disposition of Claims					
<ul> <li>4)  Claim(s) 1-3 is/are pending in the application.</li> <li>4a) Of the above claim(s) is/are withdraw</li> <li>5)  Claim(s) is/are allowed.</li> <li>6)  Claim(s) 1-3 is/are rejected.</li> <li>7)  Claim(s) is/are objected to.</li> <li>8)  Claim(s) are subject to restriction and/or</li> </ul>					
Application Papers					
9)☐ The specification is objected to by the Examiner.					
10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.					
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).					
Replacement drawing sheet(s) including the correct 11) The oath or declaration is objected to by the Ex					
Priority under 35 U.S.C. § 119		•			
<ul> <li>12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</li> <li>a) All b) Some * c) None of:</li> <li>1. Certified copies of the priority documents have been received.</li> <li>2. Certified copies of the priority documents have been received in Application No.</li> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> <li>* See the attached detailed Office action for a list of the certified copies not received.</li> </ul>					
Attachment(s)					
1) Notice of References Cited (PTO-892)  4) Interview Summary (PTO-413)  Paper No(s)/Mail Date:					
<ul> <li>2) Notice of Draftsperson's Patent Drawing Review (PTO-948)</li> <li>3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)</li> <li>Paper No(s)/Mail Date</li> </ul>	5. D. 1. 1. 1. 1.	ate Patent Application (PTO-152)			

### **DETAILED ACTION**

This action is in response to applicant's amendment submitted on September 18, 2006. Examiner acknowledges the amended claims in response to the first office action.

## Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action of May 18, 2006.

Claim 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Raymond et al. (US Patent No. 5,775,331). Please see prior Office action of May 18, 2006 for details of the rejection.

### **Response to Arguments**

Applicant's arguments filed September 18, 2006 have been fully considered but they are not persuasive. Applicant asserts, Raymond does not disclose a device or method for handling diseased tissue nor for electing a diseased tissue deliberately. However, Examiner notes one of the objectives of Raymond's invention is successful localization of a target nerve (Column 5, line 8 – Column 6, line 60). Examiner contends that this localization of a "target nerve" is analogous to the handling or electing of the "diseased tissue," and thus anticipates the present invention as claimed.

Applicant further goes on to argue that Raymond fails to teach or suggest a device or a method that is used to select and/or remove pathologically altered tissue. However, Examiner contends Raymond does anticipate surgical treatment of the selected site (Column 18, lines 22-38), as claimed. Moreover, Examiner points out that

the selection and/or removal pathologically altered tissue are not in concert with the claimed language. In the claim, the applicant uses "carrying out the corresponding to a surgical treatment..." and does not positively recite the removal of pathologically altered tissue. The applicant should amend the claim to positively recite those limitations lacking from the prior art.

#### Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 3736

TWO MONTHS of the mailing date of this final action and the advisory action is not . mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anuradha Roy whose telephone number is 571-272-6169 and whose email address is anuradha.roy@uspto.gov. The examiner can normally be reached between 9:00am and 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor. Max Hindenburg can be reached on 571-272-4726.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Mot Handrey Business Center (EBC) at 866-217-9197 (toll-free).